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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,580	06/20/2001	Naohiko Moriyama	AAO-255	1490

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Rader Fishman & Grauer
1233 20th Street NW Suite 501
Washington, DC 20036

EXAMINER

CHORBAJI, MONZER R

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/868,580	Applicant(s) MORIYAMA ET AL.	
	Examiner MONZER R CHORBAJI	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
4. Claims 1-5, 10-14 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/049,232 in view of Treu et al (U.S.P.N. 5,788,099).

This is a provisional obviousness-type double patenting rejection.

With respect to claims 1, 10, 14 and 19 of 09/868,580, claims 1-2 of 10/049,232 teaches the following: a source of water is equivalent to the water being applied in claim 1, line 15; an opener including a holder is equivalent to the container holder structure in claim 1; claims of both cases include a cylindrical cutter with a cutting edge for cutting the sealing member of the container along the periphery of the opening; a receiving member in the form of a mesh is equivalent to the mesh member in claim 1, line 10; claims of both cases uses nozzle; and claims of both cases uses a tank. However, with respect to claims 1, 10, 14 and 19 of 09/868,580, claims 1-2 of 10/049,232 fail to teach

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the following: a mechanism for vertically moving the holder toward the cutter, a sprayer, a cutter with an inclined edge with a slit, and an apparatus for preparing a fluid that includes two devices. The ('099) reference discloses the following: a sprayer (142), a cutter with having an inclined edge with a slit (242, 334 and 146) and an apparatus for preparing a fluid that includes two devices (col.5, lines 30-31). However, the ('099) reference fails to teach a mechanism for vertically moving the holder toward the cutter such that choosing one moving part (a vertically moving holder) over another (a vertically moving spike) in order to obtain the dry chemical is a matter of routine experimentation.

With respect to claims 4 and 12 of 09/868,580, claim 2 of 10/049,232 discloses the size of the mesh member.

With respect to claims 2-3 and 11 of 09/868,580, the ('099) reference teaches the following: a mixing tank connected to the sprayer and the tank is supplied by a water source (figure 2, 122, 108 and unlabeled line connecting the tank to sprayer 142), housing is made up of 368 and 110 such that 110 includes receiving member 134 such that choosing one moving part (a vertically moving holder) over another (a vertically moving spike) in order to obtain the dry chemical is a matter of routine experimentation. With respect to claims 5 and 13 of 09/868,580, the ('099) reference teaches a motor for driving belt (348) to rotate the threaded drive collar (340), a nut (unlabeled nut upon which the belt is mounted) engaging the feed screw (340), a member (figure 4, 334) connected between the nut and the holder (160).

5. Claims 6-9 and 15-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/049,232 in view of Treu et al (U.S.P.N. 5,788,099) and further in view of Bernstein et al (U.S.P.N. 5,366,114).

With respect to claims 6, 9, 15 and 18, both the claims of 1-2 of 10/049,232 and the ('099) reference fail to disclose the concept of cutter with a serrated cutting edge. However, the ('114) reference teaches a piercing insert with a serrated edge (54). Thus, it would have been obvious to one having ordinary skill in the art to modify the cutter of the claims of 10/049,232 to include a serrated cutting edge in order to rupture the frangible membrane of the container as taught by the ('114) reference (abstract, lines 11-12).

With respect to claims 7-8 and 16-17, the ('114) reference does not teach a cutter with partial serrated portion or the serrated portion is disposed on the proximal half of the inclined end, however; such obvious modifications are a matter of routine experimentation.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention

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was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

6. Claims 1-5, 10-14 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 16 of copending Application No. 09/958,938 in view of Treu et al (U.S.P.N. 5,788,099) and further in view of Larson et al (U.S.P.N. 6,210,646).

This is a provisional obviousness-type double patenting rejection.

With respect to claims 1, 10, 14 and 19 of 09/868,580, claims 1 and 16 of 09/958,938 teaches the following: a source of water is equivalent to the water control means in claim 16, line 11; an opener including a holder is equivalent to the container holder structure in claim 1, lines 8-9 and the container holder in claim 16, lines 3-5; claims of both cases include a cutter for cutting the sealing member of the container as in claim 1, lines 10-11 or as in means for opening the sealing member as in claim 16, lines 13-14; a tank is equivalent to the tank in claim 1, line 17 and the tank in claim 16, line 9; and the claims of both cases use a nozzle. However, with respect to claims 1, 10, 14 and 19 of 09/868,580, claims 1 and 16 of 09/958,938 fail to teach the following: a mechanism for vertically moving the holder toward the cutter, a sprayer, a receiving member in the form of a mesh, a cylindrical cutter with an inclined edge including a slit, and an apparatus for preparing a fluid that includes two devices. The ('099) reference discloses the following: a sprayer (142), a cylindrical cutter with having an inclined edge and a slit (242, 334 and 146) and an apparatus for preparing a fluid that includes two devices (col.5, lines 30-31). However, the ('099) reference fails to teach a receiving

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member in the form of a mesh and a mechanism for vertically moving the holder toward the cutter. Regarding the mechanism for vertically moving the holder toward the cutter, choosing one moving part (a vertically moving holder) over another (a vertically moving spike) in order to obtain the dry chemical is an obvious modification which is a matter of routine experimentation. The ('646) reference, which is in the art of dispensing, teaches the use of a screen assembly, i.e., a mesh, (col.6, lines 17-26). As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus claims of copending Application No. 09/958,938 to include a screen assembly in order to distribute the flow of water uniformly over a large surface area as taught by the ('646) reference (col.6, lines 24-26).

With respect to claim 2 of 09/868,580, claims 1 and 16 of 09/958,938 teaches a tank which is a part of circulating system.

With respect to claims 5 and 13 of 09/868,580, the ('099) reference teaches a motor for driving belt (348) to rotate the threaded drive collar (340), a nut (unlabeled nut upon which the belt is mounted) engaging the feed screw (340), a member (figure 4, 334) connected between the nut and the holder (160).

With respect to claim 11 of 09/868,580, the ('099) reference teaches a housing which is made up of 368 and 110 such that 110 includes receiving member 134 such that choosing one moving part (a vertically moving holder) over another (a vertically moving spike) in order to obtain the dry chemical is a matter of routine experimentation.

With respect to claim 3, the ('099) reference discloses a housing, which is made up of 368 and 110 such that 110 includes receiving member 134 such that choosing

one moving part (a vertically moving holder) over another (a vertically moving spike) in order to obtain the dry chemical is a matter of routine experimentation.

With respect to claims 4 and 12, the ('646) reference discloses a screen assembly (i.e., a mesh) in col.6, lines 17-26 such that choosing the mesh size is a matter of routine experimentation.

7. Claims 6-9 and 15-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 16 of copending Application No. 09/958,938 in view of Treu et al (U.S.P.N. 5,788,099) and further in view of Larson et al (U.S.P.N. 6,210,646) and Bernstein et al (U.S.P.N. 5,366,114).

With respect to claims 6, 9, 15 and 18, the claims of 1-2 of 10/049,232, the ('099) reference and the ('646) reference fail to disclose the concept of cutter with a serrated cutting edge. However, the ('114) reference teaches a piercing insert with a serrated edge (54). Thus, it would have been obvious to one having ordinary skill in the art to modify the cutter of the claims of 10/049,232 to include a serrated cutting edge in order to rupture the frangible membrane of the container as taught by the ('114) reference (abstract, lines 11-12).

With respect to claims 7-8 and 16-17, the ('114) reference does not teach a cutter with partial serrated portion or the serrated portion is disposed on the proximal half of the inclined end, however; such obvious modifications are a matter of routine experimentation.

Claim Rejections - 35 USC § 103

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-5, 10-14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treu et al (U.S.P.N. 5,788,099) in view of Larson et al (U.S.P.N. 6,210,646).

With respect to claims 1, 10, 14 and 19, the ('099) reference teaches the following: a source of water (120), an opener including a holder (160 and unlabeled part just beneath 250 in figure 5A), a cylindrical cutter for partially cutting the membrane along the periphery of the opening (242, 334 and 148), a cutter with an inclined edge and a slit (242 and 146), a nozzle (142), a tank (108), a holder for vertically holding the vessel (the unlabeled part just beneath 250 in figure 5A), a sprayer (142), and an apparatus for preparing a fluid that includes two devices (col.5, lines 30-31). However, the ('099) reference fails to teach a receiving member in the form of a mesh and a mechanism for vertically moving the holder toward the cutter. Regarding the mechanism for vertically moving the holder toward the cutter, choosing one moving part (a vertically moving holder) over another (a vertically moving spike) in order to obtain the dry chemical is an obvious modification which is a matter of routine experimentation. The ('646) reference, which is in the art of dispensing, teaches the use of a screen assembly, i.e., a mesh, (col.6, lines 17-26). As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus claims of copending Application No. 09/958,938 to include a screen assembly in order to distribute the flow of water uniformly over a large surface area as taught by the ('646) reference (col.6, lines 24-26).

With respect to claim 2, the ('099) reference discloses a circulation system between the tank and the sprayer (figure 2, 108, 110 and unlabeled lines connecting both structures).

With respect to claims 5 and 13, the ('099) reference teaches a motor for driving belt (348) to rotate the threaded drive collar (340), a nut (unlabeled nut upon which the belt is mounted) engaging the feed screw (340), a member (figure 4, 334) connected between the nut and the holder (160).

With respect to claims 3 and 11, the ('099) reference discloses a housing, which is made up of 368 and 110 such that 110 includes receiving member 134 such that choosing one moving part (a vertically moving holder) over another (a vertically moving spike) in order to obtain the dry chemical is a matter of routine experimentation.

With respect to claims 4 and 12, the ('646) reference discloses a screen assembly (i.e., a mesh) in col.6, lines 17-26 such that choosing the mesh size is a matter of routine experimentation.

12. Claims 6-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treu et al (U.S.P.N. 5,788,099) in view of Larson et al (U.S.P.N. 6,210,646) and further in view of Bernstein et al (U.S.P.N. 5,366,114).

With respect to claims 6, 9, 15 and 18, both the claims of 1-2 of 10/049,232 and the ('099) reference fail to disclose the concept of cutter with a serrated cutting edge. However, the ('114) reference teaches a piercing insert with a serrated edge (54). Thus, it would have been obvious to one having ordinary skill in the art to modify the cutter of the claims of 10/049,232 to include a serrated cutting edge in order to rupture the frangible membrane of the container as taught by the ('114) reference (abstract, lines 11-12).

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With respect to claims 7-8 and 16-17, the ('114) reference does not teach a cutter with partial serrated portion or the serrated portion is disposed on the proximal half of the inclined end, however; such obvious modifications are a matter of routine experimentation.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 6:30-3:00.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT J WARDEN can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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